

REMARKS/ARGUMENT

Description of Amendments

In this Amendment, claims 1 and 2 have been amended, claims 7, 17, and 20 have been canceled. Claims 1-6, 8-16, 18 and 19 are pending after entry of this Amendment. Reconsideration of the application is requested.

No new matter is introduced by this Amendment. Currently amended claims 1 and 2 are supported at least by the originally-filed specification corresponding to original claims 7 and 17.

Information Disclosure Statement

Applicant notes that the examiner has signed the 1449 forms submitted with Applicant's prior-filed information disclosure statement. However, because the examiner failed to place his initials next to any of the references cited on the 1449 forms, the record is unclear as to whether the references were considered. Applicant kindly requests the examiner to place his initials next to all the references and return the initialed 1449 forms to Applicant.

Rejection under 35 U.S.C. §102

Claims 1, 3-6, 8-12, 14-16, and 18-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Davis, et al., U.S. Patent 6,105,008. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Davis et al. fail to teach or disclose the limitations of claims 7 and 17. Independent claims 1 and 12 have been amended to include the limitations of claims 7 and 17, respectively. Accordingly, Applicant submits that claims 1 and 12, and the claims depending therefrom, are patentably allowable over Davis et al.

Independent claim 20 has been canceled, rendering its rejection moot.

Rejection under 35 U.S.C. §103

I.

Claims 7 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davis *et al.* For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 7 and 17 have been canceled and their subject matter moved to claims 1 and 12, respectively. Claims 1 and 12 as amended therefore include the limitation that “the secure device provides the terminal with the encrypted personal data prior to and separately from the first key.” Applicant respectfully submits that Davis *et al.* fails to teach, suggest, or otherwise make obvious this limitation of claims 1 and 12.

The Examiner argues that:

Without the key, the data cannot be decrypted. If the key were provided inside the encrypted data, there would be no way to obtain either the key or the data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the key separately from the personal information.

The Examiner’s line of reasoning does not support a *prima facie* showing of obviousness since the Examiner’s basic assertion that the key must be provided separately from encrypted personal data is incorrect. Applicant submits that it is possible to provide a key together with encrypted data, as evidenced by Davis *et al.* which provides that a first card signature may be included in a load request message (col. 26, lines 18-20) and that a security module signature is part of a load command (col. 26, lines 34-36).

In addition, Applicant submits that the examiner only mentions the encryption key shared by the servers in Davis *et al.*, and does not mention any security key associated with the personal data as recited in claims 1 and 12.

Accordingly, Applicant respectfully submits that claims 1 and 12, and the claims depending therefrom, are patentably allowable over Davis *et al.*

II.

Claims 2 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davis *et al.* As indicated in Section I above, claims 1 and 12 are patentably allowable over

Davis *et al.* Claims 2 and 13 depend from claims 1 and 12, respectively, and are patentably allowable over Davis *et al.* for at least the same reason as claims 1 and 12.

Conclusion

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-0150.

Respectfully submitted,

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